

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the reasons that follow.

I. Status of Claims

With this submission, no claims are amended, canceled or newly added. Hence, upon entry of this paper, claims 5, 8-12, and 15 will remain pending and under active consideration.

II. Rejections Withdrawn

Applicant wishes to thank the Examiner for withdrawing the rejection of claims under 35 U.S.C. §103 and 35 U.S.C. §112, second paragraph.

III. Rejection Under 35 USC § 103

The Office rejects claims 5, 8-12 and under 35 U.S.C. § 103(a) as allegedly being unpatentable over Akiyama et al. (WO 2004/024184), EP 1 537 880 ("Akiyama") in view of Nauck *et al.*, *Diabetes Care* 21:1925-1931 (1998) ("Nauck"). (Office Action, page 3)
Applicant respectfully traverses this rejection.

Applicant notes that this is the only remaining rejection.

A. Akiyama Does Not Qualify as Prior Art

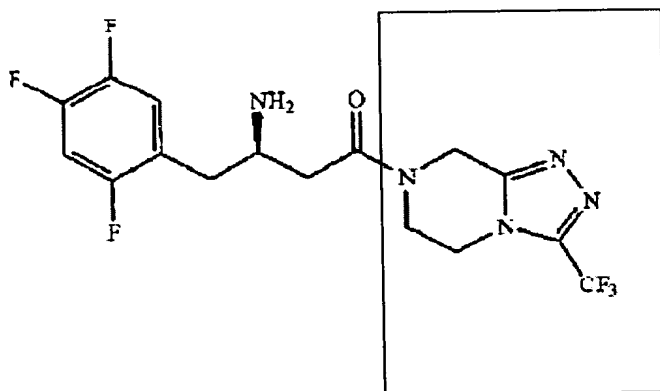
The Office cites Akiyama WO 2004/024184 as prior art against the Applicant. However, Akiyama does not qualify as prior art under 35 USC §103 as to all claims. Applicant attaches a copy of the JP 2003-345740 priority document (Exhibit A). Support for claims 5 and 8-14 can be found in this priority document. Therefore, Applicant's priority date in regards to these claims is October 3, 2003.

B. Claim 15 is Non-Obvious over Akiyama and/or Nauck

The Office argues that specific DPP-IV inhibitors are represented by formula I [0015] and formula II [0027]-[0048] of the Akiyama reference. The Office then states that the

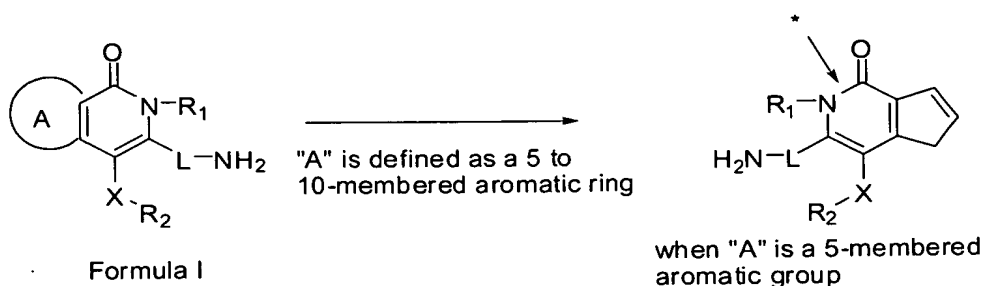
“formula is substantially the same as the formula of the instant specification which is disclosed as the formula for the compound of instant claim 15” (Office Action, page 3). Applicant respectfully disagrees.

The compound shown in claim 15 is completely different from any structure shown in Akiyama. It is true that Formula I and Formula II of both Akiyama and the instant application are similar. However, the compound shown in claim 15 is completely different from both Formula I and Formula II. In fact the compound shown in claim 15 is so different that it was specifically placed in a separate genus from both Formula I and Formula II. For convenience, the compound shown in claim 15 is reproduced below (Applicant boxed the relevant structure that is clearly not disclosed in either Formula I or II):



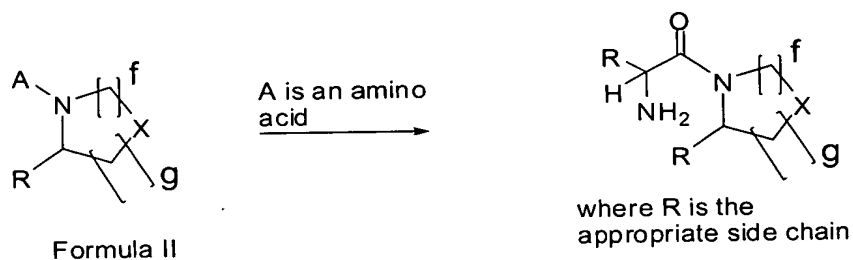
The genus described in both Formula I and Formula II do not encompass the compound shown in claim 15. First, Formula I and Formula II do not disclose the correct nitrogen orientations, in fact, Formula I and Formula II do not disclose the use of more than 1 nitrogen in the heterocyclic structure. The compound in claim 15 has four nitrogens in the heterocyclic structure. Additionally, neither Formula I or II disclose the use of fluorines on the aromatic structure (much less the use of three fluorines). These alone should render claim 15 non-obvious over Akiyama.

However, there are even more differences between the structures disclosed in Akiyama and the structure of claim 15. The closest structure encompassed by Formula I is a 5-membered ring fused to an aromatic ring. Applicant reproduces the closest structure to claim 15 that would be encompassed by Formula I:



In Formula I, "A" is not defined as heteroaromatic. Therefore, Formula I will not allow the formation of a 5,6-fused system that has 2 nitrogens in the 6-membered ring and a five-membered fused ring having three nitrogens. Specifically, Formula I cannot form a triazolopyrazinyl system as shown in claim 15.

Similarly, the closest structure encompassed by Formula II does not include a fused ring. Applicant reproduces the closest structure to claim 15 covered by Formula II:



Formula II cannot encompass a 5,6-fused ring system because the "A" group is pendant on the N-atom.

The Office uses Nauck for the proposition that an inhibitor of DPP-IV can be used to treat diabetes with sulfonylurea secondary failure. As such, Nauck does not cure the deficiencies of Akiyama in failing to teach or suggest a compound with the structure of claim 15.

For at least these reasons, Applicant respectfully requests reconsideration and withdrawal of the rejection.

CONCLUSION

Based on the foregoing remarks, Applicant respectfully requests that the Examiner reconsider all rejections and that they be withdrawn. Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

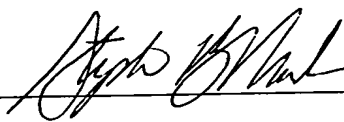
The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. § 1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date Aug. 26, 2010

FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 672-5569
Facsimile: (202) 672-5399

By 

Stephen B. Maebius
Attorney for Applicant
Registration No. 35,264

Shine Tu
Registration No. 62,863

EXHIBIT A